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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,991	12/08/2003	Haruhisa Masuda	246245US0	2812
22850 7590 04/16/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MULLIS, JEFFREY C	
			ART UNIT	PAPER NUMBER
			1711	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/16/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/16/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/728,991

Applicant(s)

MASUDA ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-16 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3-12-07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claims 1-4, 11-16 and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed does not disclose applicants newly presented limitation to claim 1 which is therefore new matter.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 11-16 and 23-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakamura (JP 20020060500).

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Patentees disclose in paragraphs 57-58 Example 4 having 30 parts poly(ethylene-vinylalcohol), 40 parts modified SEBS (described at paragraph 55) and 23 parts of process oil (described as a flexibilizer and therefore a plasticizer at paragraphs 38 and 39). Note that applicants oxygen permeation coefficient characteristic is explicitly disclosed in the table. Note use of polypropylene at paragraph 40. Since all components required by applicants claims are present applicants remaining characteristics reasonably appear to be inherent in the patent.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 1-4, 11-16 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tai et al (JP 2002-146217) in view of Hibi et al. (JP 04-292647), both newly cited by applicants.

Tai '217 corresponds to US 20030018114 and the US document will be referred to as it is in English.

Tai discloses all elements of applicants composition except that the document is silent with re to the amount of plasticizer to be used. Note paragraphs 126, 274 and 278

for modified SEBS, use of plasticizer at paragraph 168 and applicants remaining amounts at paragraph 20.

Hibi discloses the use of 30 parts hydrocarbon plasticizer per 20 parts SEBS block copolymer in their examples.

Use of Hibis' amounts of plasticizer in the primary reference would have been obvious to a practitioner having an ordinary skill in the art the time of the invention motivated by the disclosure of the primary reference that plasticizers may be added and by the need to know what particular amounts of material are effective as plasticizer for styrenic block copolymers in order to practice the embodiments of the primary reference, absent any showing of surprising or unexpected results.

Claims 1-4, 11-16, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraki et al (US 5,332,784).

Patentees disclose a composition containing a styrenic block copolymer and ethylene vinyl alcohol block copolymer (Example 80 in column 41). Plasticizing oil may be added to the composition at column 25, lines 50-55 at a level of 30 parts per 100 parts of block copolymer (column 29, lines 25-30). The material may be formed into layers at column 26, lines 39-41. Polypropylene may be added at column 13, line 26 or chlorinated polypropylene at column 21, line 40.

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No Examples exist showing all of applicants 3 required materials (or four materials as in claim 11) in applicants' amounts. However, selection of such from the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

Claims 1-4, 11-16 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda (US 2003/0162897).

Patentees disclose a composition containing a modified block copolymer and ethylene vinylalcohol copolymer as well as plasticizer and polypropylene all of which may be present in applicants amounts (paragraphs 36, 37 and 44-46). Note paragraph 71 for applicants oxygen transmission rates.

No Examples exist showing all of applicants 3 required materials (or four materials as in claim 11) in applicants' amounts. However, selection of such from the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Applicant's arguments filed 3-12-07 have been fully considered but they are not persuasive. Masuda has been withdrawn based on applicants' amendment.

With the exception of Voss, the case law cited dealt with inherency as support for a limitation. No issues of inherency are present with re to the above rejection under 35 USC 112, first paragraph. With re to Voss, while support was not *ipsis verbis*, support for "not permanently affixed thereto" was implied by applicants specification as filed by disclosure that microcapsules produced were free flowing powders and could be removed by vacuuming etc. No such implied support exists in the instant case. However, the above rejection under 35 USC 112, first paragraph as well as that relying on Shiraki can be removed by removing the above newly added limitation and inserting – wherein said modification comprises modification to introduce said functional group after terminating the polymerization used to produce said block copolymer --.

With re to Shiraki, patentees modification is a reaction of the active chain end of the block copolymer present prior to polymerization, not reaction of a compound with an initiator and hence applicants amendment does not overcome the above rejection. With re to unexpected results, such must be with the closest prior art which appears to be Nakamura, newly cited by applicants and relied upon above.

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Any inquiry concerning this communication should be directed to Jeffrey C. Mullis
at telephone number 571 272 1075, M-F, 9-5.

Jeffrey C. Mullis
J Mullis
Art Unit 1711

JCM

4-4-07

Jeffrey Mullis
Primary Examiner
Art Unit 1711

A handwritten signature in black ink, appearing to be 'JCM', located below the printed name and title of Jeffrey Mullis.